



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,188	07/08/2003	Richard L. Sutherland	SAIC0078	7745
27510	7590	09/29/2005	EXAMINER	
KILPATRICK STOCKTON LLP 607 14TH STREET, N.W. WASHINGTON, DC 20005			ROSENBERGER, RICHARD A	
			ART UNIT	PAPER NUMBER
			2877	

DATE MAILED: 09/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

H.A

**Office Action Summary**

Application No.

10/614,188

Applicant(s)

SUTHERLAND ET AL.

Examiner

Richard A. Rosenberger

Art Unit

2877

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-38 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/8/03; 7/31/03</u> . | 6) <input type="checkbox"/> Other: ____  |

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-34, drawn to a method and apparatus of determining the presence of a target agent, classified in class 356, subclass 445.
  - II. Claims 35-38, drawn to a method of making a sensor element, classified in class 430, subclass 1.
  
2. The inventions are distinct because the filter of group I which has the at least one detection molecule need not be made in the particular manner of group II; it appears that the intended scope of at least the independent claims of group I is such as to allow of such filters made by other methods. Further, the method of group II could produce elements which are useful in other methods and apparatus than that of group I, such as a detection method without the particular reference filters that do not include the detection molecules as required by all the claims of group I.
  
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, the search required for Group I is not required for Group II, and the two inventions have separate status in the art because of their recognized divergent subject matter, and the divergent subject matter would require not only different searches but different treatments with different issues arising for each of the two, restriction for examination purposes as indicated is proper. Further, it appears that the

unpatentability of the claims of one group would not imply the unpatentability of the claims in the other.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Receipt is acknowledged of the information disclosure statements filed 8 July 2003 and 31 July 2003. The information disclosure statements have been placed in the application file, and the information referred to therein has been considered as to the merits. See the attached forms PTO-1449.

On one of the sheets of the IDS's filed 31 July 2003, one of the references, numbered 41, has been lined through and has not been considered because the patent number, issue date and patentee do not agree with each other and it is not

clear what document is intended to be cited. It is noted that the patent number is the same as a patent elsewhere in the same sheet, number 35, which document has been considered.

On the IDS filed 8 July 2003, one of the references, on page 8 or 8, has been lines through and has not been considered because a copy was not found in the file and the reference was otherwise not readily available.

7. The numerous references and materials listed on the submitted IDS's make it difficult to determine whether or not any of the references, or parts of the references, are material to applicants' claimed invention. It is noted that applicants, in their several IDS submissions, do not indicate any particular reference or parts of references which they deem "material" to the patentability of the pending claims under 37 CFR 1.56(b).

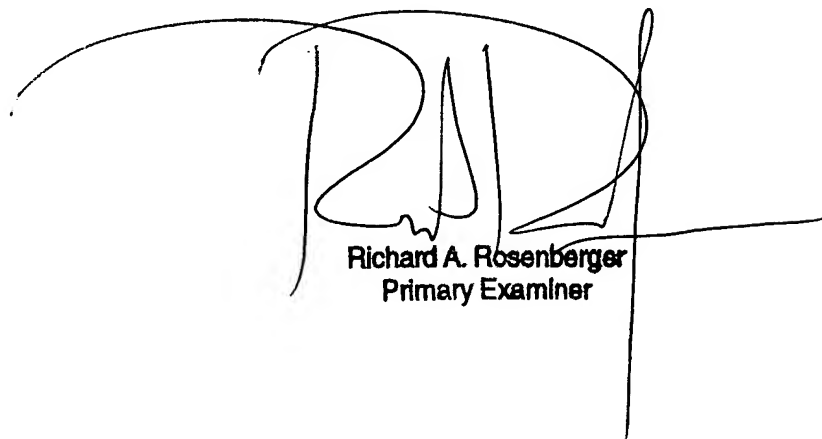
Applicants are reminded of the standard set forth in the leading inequitable conduct case of *J.P. Stevens & Co. v. Lex Tex Ltd.*, 747 F.2d 1553, 223 USPQ 1089 (Nov. 9, 1984), cert. denied, 106 S.Ct. 73 (1985): Where none of the prior art cited during prosecution teaches a key element of the claim(s) and where a reference known to the applicants does, the applicants should know that reference is material. Thus, if applicants are aware of any cited reference from among the information disclosures of 8 July 2003 or 31 July 2003 that are "material," applicants should specifically make that reference known to the examiner.

It is also noted that a "misrepresentation is material if it makes it impossible for the Patent Office fairly to assess [the patent] application against the prevailing statutory criteria." *In re Multidistrict Litig. Involving Forst Patent*, 540 F.2d 601, 604, 191 USPQ 241, 243 (3d Cir. 1976); see also *Monsanto Co. v. Rohm & Haas Co.*, 456 F.2d 592, 600, 172 USPQ 323, 329 (3d Cir.), *ce. rt. denied*, 40'7 U.S. 934, 174 USPQ 129 (1972). And, the submission of voluminous documents in the instant information disclosure statements (here, approximately 200 documents) make it difficult, and likely impossible, for the Patent Office to fairly assess applicants' application against the prevailing statutory criteria.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard A Rosenberger whose telephone number is (571) 272-2428. The examiner can normally be reached on Monday through Friday during the hours of 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory J. Toatley, Jr. can be reached on (571) 272-2800 ext. 77. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

R. A. Rosenberger  
26 September 2005



Richard A. Rosenberger  
Primary Examiner